

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)	
)	
Anke Gerda Sinnema et al.)	
)	
Serial No.: 10/559,360)	Group Art Unit: 3724
)	
Filed: December 6, 2005)	Examiner: Clark F. Dexter
)	
For: SHAVING APPARATUS)	Board of Patent Appeals and
)	Interferences
)	
)	
Confirmation No.: 5647)	

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

In support of the Notice of Appeal filed on June 29, 2009, in response to the Notice of Non-Compliant Appeal Brief of November 23, 2009, and pursuant to 37 C.F.R. § 41.37, Appellants present this Appeal Brief in the above-captioned application.

This is an appeal to the Board of Patent Appeals and Interferences from the Examiner's final rejection of claims 1-5 and 13 in the Non-Final Office Action dated June 9, 2009. The appealed claims are set forth in the attached Claims Appendix.

1. Real Party in Interest

This application is assigned to Koninklijke Philips Electronics N.V., the real party in interest.

2. Related Appeals and Interferences

There are no other appeals or interferences that would directly affect, be directly affected, or have a bearing on the instant appeal.

3. Status of the Claims

Claims 6-12, 14-22, and 36 have been cancelled. Claims 23-35, 37, and 38 have been withdrawn. Claims 1-5, 13, 23-35, 37, and 38 are presently pending. Claims 1-5 and 13 have been rejected in the Non-Final Office Action. The final rejection of claims 1-5 and 13 is being appealed.

4. Status of Amendments

All amendments submitted by Appellants have been entered.

5. Summary of Claimed Subject Matter

The present invention, as recited in independent claim 1, relates to a shaving apparatus (10) having a skin contact surface (16) accommodating at least one cutting unit (3). (See Specification, ¶¶ [0018]-[0020], Fig. 1). The cutting unit (3) includes an external cutting member (4), a matching internal cutting member (6), and a device (20) for providing a shaving aid additive to said skin contact surface (16). (See Id., ¶¶ [0018]-[0021]). The cutting unit (3) is characterized by shaving aid additive retaining means provided on at least part of the skin contact surface (16). (See Id., ¶ [0024]). The shaving aid additive is one of a liquid, a gel, a foam, a cream, and a water-soluble hard material. The shaving aid additive retaining means

includes a plurality of grooves (34, 35, 36) that prevent the shaving aid additive from entering apertures (5) in the external cutting member (4). (See Id., ¶ [0025]).

6. Grounds of Rejection to be Reviewed on Appeal

- I. Whether claims 1-5 and 13 are anticipated under 35 U.S.C. §102(e) by U.S. Published App. No. 2002/0083591 to Geertsma et al. (hereinafter “Geertsma”).
- II. Whether the objections to claims 4 and 5 should, in fact, be rejections under 35 U.S.C. §112, first paragraph, and therefore be appealable to the Board.

7. Argument

- I. The Rejection of Claims 1-5 and 13 Under 35 U.S.C. § 102(e) Should Be Reversed.

A. The Examiner’s Rejection

In the Non-Final Office Action, the Examiner rejected claims 1-5 and 13 under 35 U.S.C. §102(e) as anticipated by Geertsma. (See 6/9/09 Office Action, pp. 4-6). This same rejection was also presented to the Appellants twice previously.

- B. Geertsma Does Not Disclose Or Suggest The Shaving Aid Additive Retaining Means Comprises A Plurality Of Grooves That Prevent The Shaving Aid Additive From Entering Apertures In The External Cutting Member As Recited In Claim 1.

Claim 1 recites, “[s]having apparatus having a skin contact surface accommodating at least one cutting unit that comprises an external cutting member, a matching internal cutting member, and a device for providing a shaving aid additive to said skin contact surface, characterized by shaving aid additive retaining means provided on at least part of said skin contact surface, wherein the shaving aid additive is one of a liquid, a gel, a foam, a cream, and a water-soluble hard material, *wherein the shaving aid additive retaining means comprises a plurality of grooves configured to prevent the shaving aid additive from entering apertures in the external cutting member.*”

The Examiner asserts that “because Geertsma’s device discloses all of the claimed structure, it must follow that if the claimed invention can perform the claimed function, then so too can Geertsma’s device.” (See 6/9/09 Office Action, p. 6). Appellants respectfully disagree. Initially, it is respectfully submitted that Geertsma’s device includes a plurality of ridges (10) disposed on a decorative cover (9). (See Geertsma, col. 2, ll. 6-8). The Examiner refers to the spaces between these ridges to meet the recited plurality of grooves. However, the spaces between these grooves lead directly to the apertures (5) in the cutting member (4). In fact, Geertsma explicitly discloses that the purpose of the spaces between ridges (10) is “that the hairs are guided between the ridges 10 during shaving and accordingly enter the hair-trapping apertures 5 more easily.” (See Id., ll. 18-20). So, if a shaving aid additive were used in conjunction with Geertsma’s device, the shaving aid additive would be directed into the apertures (5). So, Geertsma not only fails to disclose or suggest “*the shaving aid additive retaining means comprises a plurality of grooves configured to prevent the shaving aid additive from entering apertures in the external cutting member,*” as recited in claim 1, but also teaches away from this limitation. Accordingly, it is respectfully submitted that claim 1 and its dependent claims 2-5 and 13 are allowable over Geertsma.

II. The objections to claims 4 and 5 should be rejections under 35 U.S.C. §112, first paragraph, and are therefore appealable to the Board.

A. The Examiner’s Rejection

In the Non-Final Office Action, the Examiner objected to Figures 9-12 and specification amendments submitted on 12/17/07 for introducing new matter and objected to the drawings for failing to show the features of claims 4 and 5. (See 6/9/09 Office Action, p. 2). This same objection was also presented to the Appellants twice previously.

B. Claims 4 and 5 Are Supported By The Specification

Initially, Appellants direct the Examiner’s attention to MPEP §608.04, which states “[w]hile amendments to the specification and claims involving new matter are ordinarily entered, such matter is required to be canceled from the descriptive portion of the specification,

and the claims affected are rejected under 35 U.S.C. 112, first paragraph.” Therefore, Appellants respectfully submit that the objections in the 6/9/09 Non-Final Office Action should, in fact, be considered a §112, first paragraph, rejection of the corresponding claims (claims 4 and 5).

With regards to this rejection, Appellants refer to MPEP §608.01(I), which states that the “disclosure in the claim must be sufficiently specific and detailed to support the necessary amendment of the drawing and description.” Therefore, the test is not whether the patterns submitted in the new drawings 9-12 are the only patterns that one could arrive at based on the description in the original claims and specification, but whether the disclosure of the originally filed claims and specification support the new drawings. It is unarguable that Fig. 9 shows a spiral shaped pattern of ridges, claim 10 shows a star shaped pattern of ridges, Fig. 11 shows a flower shaped pattern of ridges and Fig. 12 shows pattern of dimples as on a golf ball as described in the original claims and specification. (See Published Specification, [0026] and claims 4 and 5). Whether one could arrive at a different spiral, flower, star, etc. shape is irrelevant to the question of whether there is support for the shapes shown in Figs. 9-12. As stated above, there is no doubt that the shapes illustrated in the Figs. 9-12 are examples of those described in the original specification and claims that could be arrived at by one of ordinary skill. Therefore, Figures 9-12, added by amendment on July 3, 2008, show the features of claims 4 and 5. The specification amendments submitted on December 17, 2007 are merely short descriptions of Figs. 9-12. As stated earlier, in view of MPEP §608.01(I), claims 4 and 5 contains sufficient disclosure to support Figs. 9-12 and, accordingly, the paragraphs added after page 2, line 32 of the specification. Thus, Appellants respectfully submit that claims 4 and 5 are supported by the specification, specifically originally filed claims 4 and 5 and Figs. 9-12 (added by amendment). Therefore, the withdrawal of this rejection is respectfully requested.

8. Conclusion

For the reasons set forth above, Appellants respectfully request that the Board reverse the rejection of the claims by the Examiner under 35 U.S.C. § 102(e), and indicate that claims 1-5 and 13 are allowable.

Respectfully submitted,

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CLAIMS APPENDIX

1. Shaving apparatus having a skin contact surface accommodating at least one cutting unit that comprises an external cutting member, a matching internal cutting member, and a device for providing a shaving aid additive to said skin contact surface, characterized by shaving aid additive retaining means provided on at least part of said skin contact surface, wherein the shaving aid additive is one of a liquid, a gel, a foam, a cream, and a water-soluble hard material, wherein the shaving aid additive retaining means comprises a plurality of grooves that prevent the shaving aid additive from entering apertures in the external cutting member.
2. Shaving apparatus as claimed in claim 1, wherein said at least one cutting unit is of the rotary type comprising an external annular cutting member, and wherein first shaving aid additive retaining means are provided on the skin contact surface enclosed by the external cutting member of the at least one cutting unit.
3. Shaving apparatus as claimed in claim 2, wherein the first shaving aid additive retaining means comprise at least one ridge extending around the center of the skin contact surface enclosed by the annular cutting member of the at least one cutting unit.
4. Shaving apparatus as claimed in claim 3, wherein said at least one ridge comprises at least one of the following configurations:
 - a) a number of concentric ridges,
 - b) a spiral-shaped pattern of ridges,
 - c) a star-shaped pattern of ridges,
 - d) a flower-shaped pattern of ridges.
5. Shaving apparatus as claimed in claim 2, wherein the first shaving aid additive retaining means include a pattern of dimples in at least part of the skin contact surface.
13. Cutting unit of the rotary type for a shaving apparatus as claimed in claim 2, said cutting unit having an external annular cutting member and a skin contact surface enclosed by the external

cutting member, wherein said enclosed skin contact surface is provided with shaving aid additive retaining means.

EVIDENCE APPENDIX

No evidence has been submitted herewith or is relied upon in the present appeal.

RELATED PROCEEDINGS APPENDIX

No decisions have been rendered regarding the present appeal or any proceedings related thereto.